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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/848,758	05/19/2004	Barbara A. Christensen	RA 5609 (33012/386/101)	4640
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UNISYS CORPORATION			VY, HUNG T	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/848,758

Applicant(s)

CHRISTENSEN ET AL.

Examiner

Hung T. Vy

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In the page 1 of specification, the applicant should finish to fill the co-pending applicant number.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3, 5, 7, 9, 12, 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Respect to claim 21; the phrase "JavaScript like" renders the claim indefinite because relative degree of similarity is not ascertainable by person of ordinary skill in the art. The phrase "JavaScript like" is not defined in the specification, nor found any support in the disclosure.

With respect to claims 2-3, 5, 7, 9, 12, 19-21, claims contain the trademark/trade name JavaScript. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

trademark/trade name is used to identify/describe JavaScript and, accordingly, the identification/description is indefinite.

Claims 2-5, 12-15 and 17-20 depend from rejected claims 1 and 16 thereby render these dependent claims indefinite.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-5 and 11-21 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is “useful, tangible and concrete”. (See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that “A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility <http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the “practical application, result, concrete, useful and tangible” limitations are not claimed in Applicant’s claims, Examiner believes that the above listed claims are nonstatutory.

Further, with respect to claims 1, 11 and 21, claims recite an apparatus, however the components of an apparatus are merely software per se. An apparatus claims much recite physical structure thus enabling it to be properly categorized in one of the statutory categories of invention. Since the components of an apparatus claims 1, 11 and 21 are software per se and do not contain any physical components, the systems cannot be categorized in one of the statutory categories of invention and is thus nonstatutory.

Furthermore, with respect to claim 16, claim recites a data processing system, however the components of a data processing system are merely software per se. A data processing system claim much recites physical structure thus enabling it to be properly categorized in one of the statutory categories of invention. Since the components of a data processing system claim 16 is software per se and do not contain any physical components, a data processing systems cannot be categorized in one of the statutory categories of invention and is thus nonstatutory.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 2163

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 11-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims (see table below) of copending Application No. 10/849,473, 10/848,901, 10/848,470, and 10/848,899.

Present invention claims	10/849,473	10/848,901	10/848,470	10/848,899
Claim 1-5	1-5	1-5	1-5	1-5
6-10	6-10	6-10	6-10	6-10
11-21	11-21	11-21	11-21	11-21

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in present application are similar to claims in copending application as shown.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 11, 16 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 7,013,341. Although the

Art Unit: 2163

conflicting claims are not identical, they are not patentably distinct from each other because the claims in resent application are similar to claims in U.S. Patent No. 7,013,341.

7. Claims 1, 11, 16 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6 and 16 of U.S. Patent No. 6,832,237.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in resent application are similar to claims in U.S. Patent No. 6,832,237.

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “legacy database management system, a facility for conversion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

Art Unit: 2163

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-13 and 16-21 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Winter (U.S. Pub. No. 2004/0226027).

With respect to claims 1, 6, 11, 16 and 21, Winter discloses an apparatus comprising: a legacy data base management system (i.e. element 206, 208) having a first command language (e.g., “MFG/PRO, SAP, etc”) and having a plurality of datasets (see paragraph 0033-0035, 0051-0053); a user session (300) which generates a request in a standardized command language (see paragraph 0031, 0050-0051) for comparing (i.e. “matching the data submitted with the corresponding legacy application field”) some of said plurality of datasets within said legacy data base (see paragraph 0047); a facility for conversion (302) of said request in said standardized command language into a corresponding request in said first command language (see paragraph 0033-0035, 0051-0053); and a result produced by said legacy data base management system indicative of honoring (i.e. “get display (screen)”) said corresponding request (see paragraph 0047, 0054 and fig. 3).

With respect to claims 2-3, 7, 9, 12, 17 and 19-20, Winter discloses a Javascript object (i.e. "a Java interface that renders a screen in HTML")(see paragraph 0030, 0041, 0059)

With respect to claims 4, 8, 10, 13 and 18, Winter discloses user terminal (300) is coupled to said legacy data base management system via a publically accessible digital data communication network (see paragraph 0051 and fig 3).

With respect to claim 5, Winter discloses a database having a plurality of columns of data (i.e. "relational tables") wherein each of said plurality of datasets corresponds to a different one of said plurality of columns of data (see paragraph 0070).

11. Claims 1-21 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Shappir et al., (U.S. Pub. No. 2003/0051070).

With respect to claims 1-21, Shappier et al. discloses an apparatus comprising: a user terminal which generates a user request for bulk update of a specified dataset in a standardized object-based command language for comparing (i.e. "the API should provide a development model that is familiar to users and exposes logical units that match the processes (tasks) that the users wish to perform", (API)) (see abstract and 0013) some of said plurality of datasets within said legacy database (see fig. 1-2, abstract, paragraph 0068), Shappier et al. teaches user terminal generates a user request corresponds to fig 1 that generates high-level task orientated application programs, particularly it provides programming interface or API to access as detailed in fig. 1, abstract ; a legacy data base management system responsively coupled to said user terminal which performs

Art Unit: 2163

said bulk update of said specified dataset by execution (see paragraph 0017-0018 and 0020), Shappir et al. discloses legacy application along with legacy communication protocol performing operation on the legacy system using the database access as detailed in column 0020; of a non-standardized command language (see paragraph 0027-0028); a conversion facility for conversion of said standardized object-based command language to said non-standardized command language (see paragraph 0066), Shappier et al. discloses legacy application which is a low level application program interface connected though task server that containing a high-level application programs enables to access database system, therefore, Shappier et al. discloses conversion between low level application program and high-level application; and a result produced by said legacy database management system indicative of honoring said corresponding request (i.e. "manage and display the data stored within it" (see paragraph 0060, 0068).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winter (U.S. Pub. No. 2004/0226027) in view of Applicant Admitted Prior Art (AAPA).

With respect to claims 14-15, Winter discloses all limitations of claimed invention recited in claim 13 except Mapper data base management system. However, AAPA discloses Mapper data base management system (see page 2-3). It would have been obvious at the time the

Art Unit: 2163

invention was made to a person having ordinary skill in the art to modify Winter's system by using the Mapper data base management system structure in order to have data base management system in an efficient multi-user environment for the stated purpose has been well known in the art as evidenced by teaching of AAPA (see first paragraph, page 2).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

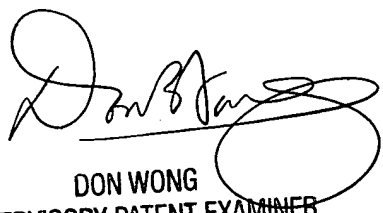
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hung T. Vy
Art Unit 2163
November 17, 2006.

Application/Control Number: 10/848,758
Art Unit: 2163

Page 11



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